

## **REMARKS**

Please reconsider the rejections of the claims in light of the following arguments and allow the pending claims.

Applicants thank the Examiner for his indication of acceptance of the previously submitted Supplemental IDS.

### **I. Rejection under 35 U.S.C. § 112, first paragraph and second paragraphs**

In the Office Action dated May 18, 2004, the Examiner rejected claims 1, 46-54, 56, 58-62, 70, 71, and 78-103 under 35 U.S.C. § 112, first and second paragraphs, because the specification, while being enabled for treating or controlling microorganisms on a surface with an anti-microbial composition, was thought by the Examiner to not be enabled for preventing microorganisms from forming on a surface.

Applicants have amended claims 1, 92-98, and 103 to replace the limitation of “prevent the formation of” with the limitation of “reduce or control the formation of”. This limitation is supported by the present Application. For example, the present application demonstrates at multiple instances that the claimed composition reduces or controls the formation of microbial colonies on or at a surface. See *e.g.*, p. 35, line 25; p. 40, line 6; p. 42, line 13; and p. 46, line 27. Therefore, it is respectfully requested that the Examiner withdraw the rejection of claims 1, 46-54, 56, 58-62, 70, 71, and 78-103 under 35 U.S.C. § 112, first and second paragraphs.

### **II. Rejection under 35 U.S.C. § 103(a)**

In the Office Action, the Examiner rejected claims 1, 46-54, 56, 58, 59, 61, 62, 70, 71, 78, 82-100, 103, and 104 under 35 U.S.C. § 103(a) as being unpatentable over

UK Patent Application No. GB 2247171 to Jackson (Jackson) in view of Sokol, et al. (CA 1087955) (Sokol).

The Examiner admitted on page 3 of the present Action that Jackson teaches a disinfectant composition that lacks polysiloxane as required by the present claims. The Examiner also stated that Sokol teaches an antimicrobial composition that includes a polysiloxane. Therefore, the Examiner concluded that it would have been obvious to one having ordinary skill in the art to modify the disinfectant composition taught by Jackson to include the polysiloxane taught by Sokol's antimicrobial composition. The Examiner stated that one of ordinary skill in the art would have been motivated to do this in order to "enhance the activity of the composition."

To establish a prima facie case of obviousness based on a combination of various references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the Applicant. In re Dance, 160 F.3d 1339, 1342 (Fed. Cir. 1998); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

There is no motivation (other than the hindsight motivation provided by the Applicants' application) to combine the Jackson and Sokol references. Jackson neither teaches nor suggests the claim 1 limitation (and, therefore, the limitations of dependent claims 46-54, 56, 58, 59, 61, 62, 70, 71, 78, 82-100 and 104) of a second compound having a low surface tension of from 8 to 14 mN/M and selected from the group consisting of silanes, soya lecithins, siloxanes and mixtures thereof. Although a composition comprising a siloxane is disclosed in Sokol *et al*, there is simply no

motivation for a person of ordinary skill to consider using this component in the disinfectant composition of Jackson.

The Examiner asserted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the siloxane of Sokol in the disinfectant of Jackson motivated with the expectation that it would have “enhanced the activity of the composition.” The motivation cited by the Examiner would not have led one of skill in the art to combine the siloxane of Sokol into the antimicrobial composition of Jackson, because the teachings of Sokol suggest that siloxane is used primarily as an “anti-foaming agent” and consequently it does not “enhance” the cleaning or sanitizing/antimicrobial effect of the mixture. Instead, due to the high amounts of detergents (*e.g.*, Tergitol® and Ultrawet®, p. 12, lines 1 – 7) present in Sokol’s compositions, the primary purpose of the siloxane is reduce the amount of foaming caused by these detergents.

In contrast, Jackson’s disinfectant lacks detergents altogether. Moreover, there is no indication in Jackson that its compositions foam excessively and should, therefore, contain a siloxane as an anti-foaming agent. Nor is there any indication that excessive foaming, even if it did occur, would even be a problem for the compositions of Jackson. Therefore, a person of ordinary skill in the art would have found no motivation to employ a siloxane, described as an optional component by Sokol *et al*, in the compositions of Jackson.

However, unlike Sokol and Jackson, the present invention recognizes that component (ii) (which includes polysiloxanes) contributes to the anti-microbial effect of the compositions. There is simply no suggestion of this activity in either Sokol or

Jackson or even in the combination of the two. Thus, the anti-microbial composition of independent claim 1 (and, therefore, dependent claims 46-54, 56, 58, 59, 61, 62, 70, 71, 78, 82-100 and 104) is inventive in view of the disclosures of Sokol and Jackson. Therefore, it is respectfully requested that the Examiner withdraw the rejection of claims 1, 46-54, 56, 58, 59, 61, 62, 70, 71, 78, 82-100 and 104 under 35 U.S.C. § 103(a).

With the exception of claim 103, all of the other claims depend from independent claim 1. In claim 103, the second low surface tension compound was previously amended with the limitation of selected from the group consisting of silanes, soya lecithins, siloxanes and mixtures thereof. Thus, the subject matter of claim 103 is non-obvious for at least the same reasons as claim 1.

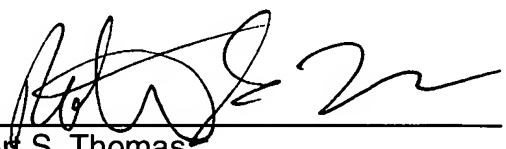
In sum, in view of the foregoing arguments, we respectfully submit that the rejected claims are patentably distinct over the references cited by the Examiner and meet all other statutory requirements. We believe that the present Application is now in complete condition for allowance and, therefore, respectfully request the Examiner to reconsider the rejections in the Office Action and allow this Application.

We invite the Examiner to telephone the undersigned should any issues remain after the consideration of this response. Please charge any additional fees that may be required to Deposit Account No. 50-2548.

Respectfully requested,

NELSON MULLINS RILEY & SCARBOROUGH

November 18, 2004  
Date



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